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OFFICE OF PETITIONS

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In re Patent No. 7,842,457
Issued: November 30, 2010
Application No. 10/767,899
Filed: January 28, 2004
Attorney Docket No. **21465-508001US**

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the SECOND REQUEST FOR RECONSIDERATION OF PATENT TERM INDICATED ON FACE OF PATENT UNDER 37 C.F.R. § 1.705(d), filed on April 4, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 413 days to 427 days.

The request for review of the patent term adjustment is **GRANTED**.

On November 30, 2010, the above-identified application matured into U.S. Patent No. 7,842,457 with a revised patent term adjustment of 413 days. On January 28, 2011, patentees timely submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 427 days.

Patentees disputed the reduction of 14 days for applicant delay and argued that the IDS filed September 9, 2010 included a certification statement, pursuant to 37 C.F.R. § 1.704(d), and should "not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under 37 C.F.R. § 1.704(c)(8)."

Patentee's argument was considered but not found to be persuasive because notwithstanding the statement under 37 C.F.R. § 1.704(d), the IDS was filed after the mailing of the Notice of Allowance and thus subject to the provisions of 37 C.F.R. § 1.704(c)(8) and not 37 C.F.R. § 1.704(c)(10)¹.

¹37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

Patentee argues further that "This reasoning is not consistent with the rule set forth in 37 C.F.R. §1.704(d), which specifies that "[a] paper containing only an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section" if it is accompanied by the appropriate statement. It is undisputed on this record that the IDS submitted on September 9, 2010 contained the proper statement under 37 C.F.R. § 1.704(d). Accordingly, this IDS should not be considered a failure to engage under any of paragraphs (c)(6), (c)(8), (c)(9), or (c)(10)."

Patentee's argument has been re-considered. The reduction of 14 days has been found to be incorrect. A review of the file, as stated by Patentee, supports a conclusion that the IDS received September 9, 2010 included a 37 CFR 1.704(d) statement.

37 CFR 1.704(d) provides that a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

In view thereof, the patent term adjustment indicated in the patent should have been four hundred twenty-seven **(427)** days.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred twenty-seven (427) days**.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,842,457 B2

DATED : November 30, 2010

INVENTOR(S) : Jan Berka

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (413) days

Delete the phrase "by 413 days" and insert – by 427 days--